REMARKS

In view of the following remarks, reconsideration and allowance are requested.

Claims 1-40, 43, 44 and 50-55 remain pending with claims 1, 14, 27, 40 and 54 being independent. Claims 11, 24, 37, 54 and 55 have been amended for clarity.

Comments of applicant's representative are preceded by related comments of the examiner in small bold type.

> **Claims 1-5, 10, 14-18, 23, 27-31, 36, 40, 43, and 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Publication No. 200210077988 to Sasaki et al. in view of U.S. Publication No. 2003/0225696 to Niwa.**
>
> **Sasaki el al. disclose receiving digital content and metadata associated with the digital content (LC. the metadata is implemented as a content header that includes information relating to an associated digital work), receiving publication information comprising distribution information that identifies one or more content distributors (i.e. the content header may include a distributor identifier) selected to distribute the digital content (see paragraphs [0038], lines 4- 16 and [0040], claim 1 and fig.4; each digital work transmission involves the packaging of the digital work and the associated content header into an encrypted transfer file that may be securely transmitted from one participating entity to another), storing the digital content at a first computing system (see paragraph [0013]- each of the portable media devices comprises a memory for storing digital content), and sending the metadata arid publication information to a computing system for storage (see paragraph [0016] a licensed digital content distributor that is configured to transmit to one or more portable media devices metadata associated with a broadcasted digital content and containing an embedded distributor identifier). Sasaki et al. do not expressly disclose sending the metadata and the publication information to a second computing system for storage separately from the first computing system. Niwa discloses sending the metadata and the publication information (i.e. information describing the content) to a second computing system for storage separately from the first computing system (see paragraphs [0072] and [0073] - the description database stores a content description table containing information describing the content.. . the description database and the video segment database are provided in separate storage media). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Sasaki et al, to include the step of sending the metadata and the publication information to a second computing system for storage separately from the first computing system. One of ordinary skill in the art would have been motivated to do this because promotes quick data transmission by reducing the amount of information stored on a data storage device.**

It is well-established that a conclusion of obviousness turns on whether the prior art suggests the desirability of the modification. MPEP § 2145 indicates that it "is improper to combine references where the references teach away from their combination." Similarly, it is

improper to modify a reference in an attempt to reject a claim where the reference teaches away from the modification.

Here, Sasaki actually teaches away from claim 1 by indicating that the digital content and the metadata are packaged into a single encrypted content package (also referred to as a "transfer file") that is passed along the distribution path from a license manager to an end user via one or more content distributors. [para. 0041; FIG. 4 shows a block diagram of a digital content transfer file] Sasaki clearly teaches away from "storing the digital content at a first computing system; and sending the metadata and the publication information to a second computing system for storage separately from the first computing system," as recited in claim 1.

It is also well-established in the MPEP that the proposed modification cannot change the principle of operation of a reference. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious." [see MPEP § 2143.01, Eighth Edition, Revision 3, August 2005, pp. 2100-138] Additionally, the second to the last paragraph in MPEP § 2143.01 states that the "proposed modification cannot render the prior art unsatisfactory for its intended purpose."

Here, Sasaki describes the invention as

> ... a novel digital content distribution scheme that enables digital content owners to *reach new potential customers by leveraging the desire of users to share and exchange digital content*, while protecting the commercial interests of digital content owners. The invention enables users to fully enjoy digital content and, at the same time, the invention prevents unchecked distribution of unlicensed digital content. The invention also features a novel content tracking and incentives system that *encourages commercial distributors, broadcasters and users to distribute digital content to new potential customers*. [para. 0005]

In order to protect the commercial interests of digital content owners, the digital content is packaged along with metatada into an encrypted content package. [para. 0041] The metadata is implemented as a content header that is used by a license manager to track and control the distribution of digital content and to administer an incentives system that encourages participating entities to distribute the digital content to potential new customers. [para. 0038]

> In particular, *a license restriction code 138 in each content header 139 limits the number of times that an unlicensed user 26 may playback an associated digital work 141.* An unlicensed user 26 may play an unlicensed digital work a number of times up to the playback limit; afterwards, the unlicensed user 26 may only play a preview sample clip of the work. *If the unlicensed user would like to play the complete digital work again, the user must purchase the work from a commercial distributor 24.* In other words, the distribution of digital content 141 is restricted to a limited number of free playbacks of the digital work and an unlimited number of free playbacks of a preview sample clip of the digital work. *As a result, potential new customers are exposed to the digital content being offered for sale without substantial risk of unrestricted distribution of the digital content.* The one or more distributor and user identifiers 135, 137, which correspond to the one or more entities in the distribution path between license manager 22 and the unlicensed user 26, may be used by license manager 22 to track the distribution of digital content to end users and to allocate incentives to the distributing entities. [para. 0039]

Given the intended purpose of encouraging distribution of the digital content to potential customers while ensuring that unlicensed users may only playback the digital content in accordance with the license restrictions set forth in the associated metadata, it is no surprise that Sasaki does not disclose separating the metadata from the digital content at any point along the distribution path. The applicant submits that modifying the Sasaki system in the manner suggested by the examiner such that "the digital content [is stored] at a first computing system; and ... the metadata and the publication information [are sent] to a second computing system for storage separately from the first computing system" would change the principle of operation of the Sasaki system and render it unsatisfactory for its intended purpose.

For the reasons stated above, independent claim 1, and the claims dependent therefrom, are patentable over the prior art. The foregoing remarks also apply to independent claims 14, 27, 40, and 54, which have corresponding limitations, and the claims that depend from claims 14, 27, 40, and 54. The applicant respectfully urges that an indication of allowability for claims 1-40, 43, 44 and 50-55 be provided.

> **Claims 6, 9, 19, 22, 32 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. and Niwa as applied to claims 1, 50, 14 and 53 above.**

Claims 7, 13, 20, 33, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al, and Niwa as applied to claims 50, 1,14, and 53 respectively above, and further in view of US Patent No. 6226618 to Downs ct al.

Claims 8, 21 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. and Niwa as applied to claims 50, 14 and 53 respectively above, and further in view of European Patent No. 104 1823 to Saito et al.

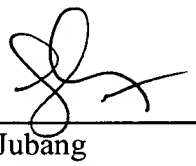
Claims 11, 12, 24, 25, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. and Niwa as applied to claims 10, 1, 23, 24, 36 and 27 respectively above, and further in view of US Publication No. 2003/0023564 to Padhye et al.

The dependent claims are patentable for at least the same reasons given with respect to the independent claims from which they depend.It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Enclosed is a $120.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 2/8/06



Mandy Jubang
Reg. No. 45,884

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906